UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,778	02/22/2002	Jim Dougherty	AINNO.0110	9862

7590   03/20/2006

David W. Carstens
P.O. Box 802334
Dallas, TX 75380-2334

EXAMINER
BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td></tr>
<tr><td>10/080,778</td><td>DOUGHERTY, JIM</td></tr>
<tr><td></td><td>Examiner</td><td>Art Unit</td></tr>
<tr><td></td><td>Adam L. Basehoar</td><td>2178</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 February 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>61-79</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>61-79</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: The RCE filed 02/06/06.

2.   Claims 1, 3-21, 23-41, and 43-60 have been cancelled as necessitated by Amendment.

3.   Claims 61-79 have been added as necessitated by Amendment.

4.   Claims 61-79 are pending in this case. Claims 61, 69, and 77 are independent claims.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 62 and 70 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 62 and 70, the phrase "may" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The Examiner suggests the claims be to be amended to include a limitation similar to "wherein the test specifications included at least one of..."

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 61-67, 69-75, and 77-79 are rejected under 35 U.S.C. 102(e) as being anticipated

by Schaefer (US-2003/0084429 05/01/03).

-In regard to independent claims 61, 69, and 77, Schaefer teaches a method for importing

specifications from a product design document for use in test software, comprising:

extracting test specification data ("data for a test case") from an electronic design

document, wherein the design document was in a structured format containing both data and

metadata (Page 4: Paragraph 53: "Alternatively, user.....Microsoft Excel file"; Page 9: Paragraph

105: "In addition....in the database");

translating the extracted test specification data into a format that was readable by the

testing software (Page 9: Paragraph 105: "In addition....in the database": i.e. test case data in an

Excel spreadsheet was translated into the tables (Fig. 2: 240) stored in the database (Fig. 2:

135)); and

importing the translated test specifications into test executive software that manages

testing and passes test specifications into applicable sections of underlying test library software

that performs specific test functions (Page 2: Paragraph 38: "The test engine component...of the

software program"; Paragraphs 54 & 55).

-In regard to dependent claims 62 and 70, Schaefer teaches wherein the test specifications

include test sequence, method, and conditions (Page 1: Paragraph 10: "test case in a table

structure....the software program; Page 4: Paragraphs 53 & 54: "wherein the data specifies the4

execution paths for testing").

-In regard to dependent claims 63 and 71, Schaefer teaches assembling a variable list containing a test parameter values from said test specifications (Pages 8 & 9, Paragraphs 0102-0103: "an "X" where output data...for the test case").

-In regard to dependent claims 64, 72, and 78, Schaefer teaches wherein the translated test specification data was stored in a database by the testing software (Page 9: Paragraph 105: "In addition....in the database")(Fig. 2: 135).

-In regard to dependent claims 65, 73, and 79, Schaefer teaches wherein the translated test specification data was stored in memory for immediate use by the testing software (Page 9: Paragraph 105: "In addition....in the database")(Fig. 2: 135).

-In regard to dependent claims 66 and 74, Schaefer teaches wherein the test specifications imported into the test executive include test specification types that are pre-defined by the test software (Page 4: Paragraph 53: "Alternatively, user.....a Microsoft Excel file"; Page 9: Paragraph 105: In addition, the data.....in the database").

-In regard to dependent claims 67 and 75, Schaefer teaches wherein the test specifications imported into the test executive include user-defined test specification types (Page 4, Paragraph 53: "User....engine component"; Page 8: Paragraph 95: "As shown in.....revising a test case.")

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims 68 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Schaefer (US-2003/0084429 05/01/03).

-In regard to dependent claims 68 and 76, Schaefer teaches monitoring the results of the

testing and storing the results in a test result as well as displaying the results in a performance

report (Page 4: Paragraph 55: "Test engine component.....performance reports"). Schaefer also

teach wherein an imported test case could cause a failure condition and may then terminate the

test (Page 9: Paragraph 108: "If test engine....if any"). Finally, Schaefer teaches wherein a user

may revise a test case and save a test case (Page 8: Paragraph 95: "revising a test case").

Schaefer does not specifically teach debugging and editing the test specification with the

test executive software in the event said design document contains mistakes and exporting the

edited test specifications into a second, revised design document. It would have been obvious to

one of ordinary skill in the art at the time of the invention for a user of Schaefer to have used the

test results file and performance reports detailing the execution of the test specification data to

revise the test specification document upon test failure, because Schaefer teaches that products

must be tested and corrected for as many "bugs" or errors as possible before placing them in a

production environment (Page 1: Paragraph 4: "Software programs....in-house use"). In this

way a fully functional and error free design document could be created and utilized for further

testing.

Response to Arguments

11.   Applicant's arguments filed 02/06/06 have been fully considered but they are not

persuasive.

-In response to the Applicant's argument that the Schaefer reference is directed toward

product testing software and not to product testing within a manufacturing environment, the

Examiner respectfully notes that mere recitations of intended use are not given patentable

weight. This is held true especially when said recitations are listed in the preamble (e.g.

"manufacturing testing software" or "product design document")(emphasis added).

-The Examiner also respectfully disagrees with the Applicant's assertion that the test

cases imported in the structured document (e.g. Excel Spreadsheet) do not constitute normative

data. The imported test cases describe input parameters for determining the proper execution of

the software program.

-Please note the newly cited prior art references when considering a response to this

Office Action. Especially in regard to the Saunders reference which is considered particularly

relevant to at least the Applicant's current independent claims.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's
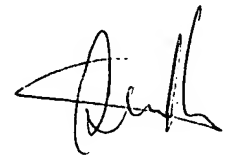
disclosure.

US-2003/0105989	06-2003	Saunders, Jimmy
US-6,336,217	01-2002	D'Anjou et al.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

STEPHEN HONG
SUPERVISORY PATENT EXAMINER